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17 OCT 2006

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In re Application of :  
AEBI et al. :  
Application No.: 10/539,659 : DECISION  
PCT No.: PCT/CH2002/000704 :  
Int. Filing Date: 17 December 2002 :  
Priority Date: None :  
Attorney Docket No.: LUS-16089 :  
For: INTERVERTEBRAL IMPLANT WITH :  
JOINT PARTS MOUNTED ON ROLLER BODIES :  
:

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 14 September 2006 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 17 December 2002, applicants filed international application PCT/CH2002/000704, which designated the United States and did not claim a priority date. A copy of the international application was communicated from the International Bureau to the USPTO on 01 July 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 June 2005.

On 14 June 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, an English translation of the international application, and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage.

On 14 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 14 September 2006, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a five month extension of time, a declaration of inventors, a declaration of facts by Carrie A. McPherson, a declaration of facts by Garry J. Tuma,

a copy of an e-mail dated 22 August 2006 from Carrie McPherson to non-signing inventor Max Aebi, a copy of a “Delivery Status Notification” for the e-mail; a copy of a letter dated 10 August 2005 from a “P. Kaiser” to a “Mr. Spaw”, and a copy of a letter dated 16 August 2005 to Mr. Spaw from a person whose signature is not legible to the undersigned.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1), (3), and (4) have been satisfied.

Item (2) has not been satisfied. MPEP § 409.03(d) states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor’s attorney. . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Here, it is not clear that a copy of the application papers including the specification, claims and drawings was sent to the last known mailing address of Mr. Aebi. Although an e-mail copy was sent to the last known e-mail address of Mr. Aebi, it is not clear whether Mr. Aebi received the e-mail. (The “Delivery Status Notification” only confirms delivery, not receipt.) “It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).” MPEP 409.03(d).

Additionally the declaration of facts of Mr. Tuma states that Mr. Aebi was already refusing to sign any papers related to the above-identified patent application as of August 2005. Copies of letters to a Mr. Spaw are provided as support. However, it is not clear whether the statement in the letter of 10 August 2005 that Mr. Aebi “is not willing to sign” is based on an express refusal by Mr. Aebi or whether this statement is a conclusion based on Mr. Aebi’s conduct. If the refusal was express, attention is directed to MPEP § 409.03(d) which states in part:

When there is an express oral refusal, that fact along with the time and place of the refusal must be

stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

If the refusal was not express but is based on Mr. Aebi's conduct, attention is directed to the following section MPEP § 409.03(d):

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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